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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/683,560	10/09/2003	Jun Tian	P0879	7905
23735	7590	07/03/2006	EXAMINER	
DIGIMARC CORPORATION 9405 SW GEMINI DRIVE BEAVERTON, OR 97008			DANG, DUY M	
			ART UNIT	PAPER NUMBER
			2624	

DATE MAILED: 07/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/683,560	Applicant(s) TIAN, JUN	
	Examiner Duy M. Dang	Art Unit 2624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR.1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 April 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 5 and 8-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 5 and 8-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) ☐ Notice of References Cited (PTO-892) | 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) ☐ Notice of Informal Patent Application (PTO-152) |
| 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) ☐ Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on April 10, 2006 has been entered.
2. Currently, claims 5 and 8-24 are pending.

Priority and Response to Arguments

3. Applicant's claim for the benefit of a prior-filed application under 35 U.S.C. 119(e) or under 35 U.S.C. 120, 121, or 365(c) is acknowledged. Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 119(e) or 120 as follows:

The later-filed application must be an application for a patent for an invention which is also disclosed in the prior application (the parent or original nonprovisional application or provisional application). The disclosure of the invention in the parent application and in the later-filed application must be sufficient to comply with the requirements of the first paragraph of 35 U.S.C. 112. See *Transco Products, Inc. v. Performance Contracting, Inc.*, 38 F.3d 551, 32 USPQ2d 1077 (Fed. Cir. 1994).

The disclosure of the prior-filed application, Application No. 09/689,293 (referred as '293 hereinafter) filed October 11, 2000, now Patent No. 6,683,966 (referred as '966 hereinafter), fails to provide adequate support or enablement in the manner provided by the first

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paragraph of 35 U.S.C. 112 for one or more claims of this application. Accordingly, claims 5 and 8-24 are not entitled to the benefit of the prior application.

4. Applicant's arguments filed on April 10, 2006 have been fully considered but they are not persuasive.

In reply to applicant's arguments as set forth in pages 6-7, it is noted that applicant's arguments fails to provide support for all claimed limitations that are recited in each of claims 5 and 8-24. Applicant has merely pointed out certain portions in the prior-filed application '293 and concluded that claims are supported by the application '293. For example, in page 6 of the applicant's response, it states:

“Support for first (and second) frequency components is found throughout the application.

For example, please see, e.g., Fig. 5 and page 8, lines 9-11 (“The watermark encoder performs the process of calculating the has in one region and embedding it in another recursively. Specifically, it calculates a hash function of region (see Fig. 5), and embeds it in region 2”).”

It is noted such citation fails to support all claimed limitations that currently recited in claims 5 and 8-24. For example, claim 5 recites:

“Apparatus which authenticates a digital representation of an object from which an analog form may be made, the apparatus comprising:

an apparatus component which uses first information in a first portion of the digital representation to produce first authentication information, the first information also being obtainable from a third portion of the analog form that is made from the first portion; and

an incorporator which incorporates the first authentication information in a second portion of the digital representation, the authentication information also being obtainable from a fourth portion of the analog form that is made from the second portion, wherein

the digital representation includes items of data with each item comprising first components and second components wherein

the items comprise DCT blocks containing frequency coefficients and the components comprise frequency coefficients in a DCT block.”

No where in the applicant’s citation found to support for all claimed limitations that are listed above. Furthermore, all other citations that applicant has pointed out in his response as set forth in page 6 fails to at least support the limitation recited in claim 5. If applicant believes that instant claims of the instant invention are support by the application ‘293, applicant’s cooperation to specifically points exactly where in the application ‘293 providing support for each limitation currently recited in each of claims 5 and 8-24 is required.

Therefore, claims 5 and 8-24 are not entitled to the benefit of the prior application ‘293 and the examiner maintains the rejections of claims 5 and 8-16 under section 35 USC 102(e) with regard to Zhao (U.S. Patent No. 6,487,301).

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an

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international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 5 and 8-24 are rejected under 35 U.S.C. 102(e) as being anticipated by Zhao (U.S. Patent No. 6,487,301. Referred as Zhao '301).

The advanced statements as applied to claims 5, 8-16 with regard to Zhao '301 set forth in paragraphs 4-5 of the previous Office action mailed on January 10, 2006 are incorporated herein.

Zhao '301 further teaches: instructions executed by electronic processing circuitry (see programs, client and server mentioned in col. 2 lines 15-22) as required by claims 17 and 21; at least electronic processing circuitry (see client 105, server 129 shown in figure 1 and mentioned at col. 2 lines 15-22) as required by claims 18 and 22; at least a machine-readable medium (such medium is inherently included in Zhao's server 129 and client 105 in order for the programs to be stored and executed) as required by claims 19 and 23; and at least one of firmware, hardware, instructions executing on digital circuitry, and a computer readable medium comprising executable instructions stored thereon (see figure 1. Note that server 129 and client 105 do included firmware inherently. Also refer to personal computer PC mentioned in col. 18 line 42) as required by claims 20 and 24.

Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Duy M. Dang whose telephone number is 571-272-7389. The examiner can normally be reached on Monday to Friday from 6:00AM to 2:30PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Matthew C. Bella can be reached on 571-272-7778. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

dmd

June 22, 2006



DUY M. DANG
PRIMARY EXAMINER